

Response to OA of July 22, 2005
Ser. No. 10/046,450

Page 7 of 14

REMARKS/ARGUMENTS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is believed to be fully responsive to all issues raised in the Office Action of July 5 22, 2005.

Claim History Summary:

Claims 1-31 were originally filed.

10 Claims 1-31 were rejected in the Office Action mailed December 30, 2003.

Claims 1, 8, 13, 18, 23 and 28 were amended in a Response of March 30, 2004.

Claims 32-39 were added in the Response of March 30, 2004.

Claims 1-39 were rejected in the Office Action mailed June 7, 2004.

15 Claims 13-31 were allowed and claims 1-12 and 32-39 were rejected in an Office Action mailed August 25, 2004.

Claims 1, 3, 8 and 32 were amended in a Response of November 26, 2004.

20 Claims 13-31 were allowed and claims 1-12 and 32-39 were rejected in an Office Action of March 9, 2005.

Claims 1, 8 and 32 were amended in a Response of June 7, 2005.

Claim Summary of Instant Office Action (July 22, 2005):

25 Claims 18-31 were allowed, claim 16 was objected to, and claims 1-15, 17 and 32-39 were rejected.

Claim Summary of Present Response:

Claims 1, 8, 9, 13, 32 and 34 are currently amended and claim 16 is canceled. Claims 1-15 and 17-39 are pending.

Response to OA of July 22, 2005
Ser. No. 10/046,450

Page 8 of 14

Rejections under 35 U.S.C. §102**Claims 1-7**

In the Office Action of July 22, 2005, claims 1-7 were rejected under §102(b) as being anticipated by Dewar et al. (USPN 5303215), referred to 5 herein as the Dewar reference. Anticipation under §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, see MPEP §2131.

Claim 1, as currently amended, recites:

10 *A storage medium comprising data stored therein through use of lands and pits and attachable to a replaceable component of an apparatus wherein the data comprises data related to the replaceable component, the replaceable component serving one or more purposes other than data storage and the storage medium operable using an electromagnetic beam and comprising a visible holographic image to authenticate the replaceable component.*
15

Applicant submits that the Dewar reference does not disclose the subject matter of claim 1. In particular, Applicant asserts that the Dewar reference does not disclose a storage medium comprising data stored 20 therein related to a replaceable component.

While the Office cites col. 5, lines 5-30 of the Dewar reference as evidence of a storage medium attached to a replaceable component of an apparatus, Applicant believes that this evidence does not support such a conclusion. Instead, the evidence appears to pertain to determining the 25 recording location of frames containing data (col. 5, lines 9-13). Again, claim 1 recites data related to a replaceable component.

Applicant further submits that the Dewar reference does not disclose the claimed "visible holographic image to authenticate the replaceable component". While the Dewar reference discloses a "holographic 30 recordings" (col. 12, lines 19-30), there is no mention of a holographic image to authenticate a replaceable component.

The Dewar reference pertains to control of location and operation of a laser relative to a code track:

35 The essential aspect of the invention which lends itself to a multitude of applications is the ability to control location and operation of the

Response to OA of July 22, 2005
Ser. No. 10/046,450

Page 9 of 14

laser (or other energetic beam or device) relative to the code track which, in accordance with the principles of the present invention, conforms to a fixed spatial relationship with the object.

5 Dewar Reference at col. 12, line 64 to col. 13, line 2.

Thus, Applicant further submits that the Dewar reference does not disclose, teach or suggest a storage medium for data related to a replaceable component, as recited in claim 1.

10 Claims 2-7 depend on claim 1 and are believed patentable over the Dewar reference for at least this reason.

Claims 13-15 and 17

15 In the Office Action of July 22, 2005, claims 13-15 and 17 were rejected under §102(b) as being anticipated by Dewar et al. (USPN 5303215), referred to herein as the Dewar reference. The Office also objected to claim 16 as being dependent on a rejected base claim.

Applicant currently amends independent claim 13 to include the language of claim 16. In other words, claim 16 is represented as
20 independent claim 13.

Claims 14, 15 and 17 depend on claim 13, as currently amended, and are believed patentable over the Dewar reference for at least this reason.

Rejections under 35 U.S.C. §103

25 In the Office Action of July 22, 2005, claims 8-12 and 32-39 were rejected under §103(a) as being unpatentable over Saruta et al. (USPN 6533383), referred to herein as the Saruta reference, in view of the Dewar reference. Obviousness under §103 requires (i) some suggestion or motivation, either in the references themselves or in the knowledge generally
30 available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (ii) a reasonable expectation of success; and (iii) that the prior art reference (or references when combined) must teach or suggest all the claim limitations, see MPEP §2143.

Response to OA of July 22, 2005
Ser. No. 10/046,450

Page 10 of 14

Claims 8, 11 and 12

Claim 8, as currently amended, recites:

5 *A print cartridge comprising a storage medium operable using an electromagnetic beam wherein the storage medium comprises lands and pits for storage of data and wherein the data comprises data related to the print cartridge.*

Applicant currently amends claim 8 to clarify that the data comprises data related to the print cartridge. As discussed above, the Dewer reference
10 does not disclose such a relationship between a storage medium and a component.

15 A prima facie rejection under §103 requires objective evidence of record to support a particular combination references. As stated in the prior Response (June 7, 2005), the Saruta reference addresses issues related to electro-magnetic interference associated with movement of a print head. As discussed above, the Dewer reference pertains to control of a laser:

20 The essential aspect of the invention which lends itself to a multitude of applications is the ability to control location and operation of the laser (or other energetic beam or device) relative to the code track which, in accordance with the principles of the present invention, conforms to a fixed spatial relationship with the object.

Dewer Reference at col. 12, line 64 to col. 13, line 2.

25 Given the problems addressed by the Saruta reference and the Dewer reference and the subject matter of claim 8, Applicant finds insufficient evidence to support combining these references. The Saruta reference simply does not call out for control of a laser nor does the Dewer reference discuss interference or noise issues or solutions.

30 Based on the subject matter of claim 8 and the references themselves, Applicant submits that the objective evidence of record is insufficient to support a prima facie rejection under §103.

35 Claims 11 and 12 depend on claim 8 and are believed patentable over the Saruta reference in view of the Dewer reference for at least the same reason as claim 8.

Response to OA of July 22, 2005
Ser. No. 10/046,450

Page 11 of 14

Claim 9

Claim 9 depends on claim 8 and recites, as currently amended: *The cartridge of claim 8 wherein the storage medium comprises a visible hologram.* Applicant added the term "visible" to indicate that the hologram is 5 visible to the eye and thereby distinguish this particular hologram from photographic recordings of data where such data is read by machine.

An analysis under §103 requires examination of a claim as a whole (see, e.g., MPEP §2141.02). Claim 9, when taken as a whole, provides for a print cartridge with a storage medium that includes both human and machine 10 readable information. The nature of the storage medium allows for storage of such information. Applicant fails to find evidence in the Saruta reference or the Dewer reference to teach such a printer cartridge. Thus, Applicant submits that claim 9 is patentable over the Saruta reference in view of the Dewer reference.

15

Claim 10

Claim 10 depends on claim 8 and recites: *The cartridge of claim 8 wherein the storage medium comprises indicia of authenticity.* The Background of the instant application states a problem: "A need exists for 20 methods and devices for storing information germane to the life-cycle of a component and for authenticating the component" (Specification at page 1, lines 19-20). The subject matter of claim 10 provides a solution to this problem as it relates to printer cartridges.

Applicant submits that the Saruta reference pertains to issues related 25 to electro-magnetic interference associated with movement of a print head and that the Dewer reference pertains to control of a laser. Neither reference addresses the pressing business need set forth in the Background or provides a solution thereto. Thus, Applicant submits that claim 10 is patentable over the Saruta reference in view of the Dewer reference.

30 While the Office states that modification of the printer cartridge of the Saruta reference by the teachings of the Dewer reference would provide an inexpensive print cartridge, Applicant submits further that such a goal is not

Response to OA of July 22, 2005
Ser. No. 10/046,450

Page 12 of 14

in-line with the stated problem. In general, goods that benefit from indicia of authenticity are not "inexpensive" but rather genuine goods that typically command a premium.

5 *Claims 32, 33, 35, 36, 38 and 39*

Independent claim 32, as currently amended, recites:

10 *A replaceable print cartridge comprising a storage medium attached thereto, the storage medium comprising lands and pits for storage of data wherein the data comprises data related to the replaceable print cartridge and wherein the storage medium is responsive to being read by an electromagnetic beam.*

Applicant currently amends claim 32 to recite that the data comprises data related to the replaceable print cartridge. As discussed above, the 15 Dewer reference does not disclose such a relationship between a storage medium and a component. Also mentioned above, the Saruta reference addresses issues related to electro-magnetic interference associated with movement of a print head. Thus, Applicant finds insufficient evidence to support combining these references. The Saruta reference simply does not 20 call out for control of a laser nor does the Dewer reference discuss interference or noise issues or solutions.

Based on the subject matter of claim 32 and the references themselves, Applicant submits that the objective evidence of record is insufficient to support a *prima facie* rejection under §103.

25 Claims 33, 35, 36, 38 and 39 depend on claim 32 and are believed patentable over the Saruta reference in view of the Dewer reference for at least the same reason as claim 32.

Claim 34

30 Claim 34 depends on claim 32 and recites, as currently amended: *The replaceable print cartridge of claim 32 wherein the storage medium comprises a visible hologram.* Applicant added the term "visible" to indicate that the hologram is visible to the eye and thereby distinguish this particular

Response to OA of July 22, 2005
Ser. No. 10/046,450

Page 13 of 14

hologram from holographic recordings of data where such data is read by machine.

An analysis under §103 requires examination of a claim as a whole (see, e.g., MPEP §2141.02). Claim 34, when taken as a whole, provides for
5 a print cartridge with a storage medium that includes both human and electromagnetic beam readable information. The nature of the storage medium allows for storage of such information. Applicant fails to find evidence in the Saruta reference or the Dewer reference to teach such a printer cartridge. Thus, Applicant submits that claim 34 is patentable over
10 the Saruta reference in view of the Dewer reference.

Claim 37

Claim 37 depends on claim 32 and recites: *The replaceable print cartridge of claim 32 wherein the storage medium comprises indicia of authenticity.* The Background of the instant application states a problem: "A need exists for methods and devices for storing information germane to the life-cycle of a component and for authenticating the component" (Specification at page 1, lines 19-20). The subject matter of claim 37 provides a solution to this problem as it relates to replaceable printer
20 cartridges.

Applicant submits that the Saruta reference pertains to issues related to electro-magnetic interference associated with movement of a print head and that the Dewer reference pertains to control of a laser. Neither reference addresses the pressing business need set forth in the Background
25 or provides a solution thereto. Thus, Applicant submits that claim 37 is patentable over the Saruta reference in view of the Dewer reference.

While the Office states that modification of the printer cartridge of the Saruta reference by the teachings of the Dewer reference would provide an inexpensive print cartridge, Applicant submits further that such a goal is not
30 in-line with the stated problem. In general, goods that benefit from indicia of authenticity are not "inexpensive" but rather genuine goods that typically command a premium.

Response to OA of July 22, 2005
Ser. No. 10/046,450

Page 14 of 14

Conclusion

Claims 1-15 and 17-39 are pending and believed to be in condition for allowance. Applicant respectfully requests reconsideration and prompt
5 issuance of the present application. Should any issue remain that prevents immediate issuance of the application, the Examiner is encouraged to contact the undersigned attorney to discuss the unresolved issue.

10

15

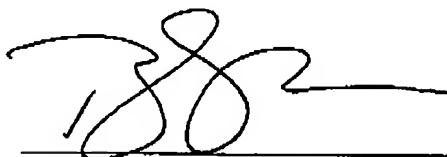
Respectfully Submitted,

Lee & Hayes, PLLC

421 W. Riverside Avenue, Suite 500
Spokane, WA 99201

20

Dated: 10-24-05



Name: Brian J. Pangrle

Reg. No. 42,973

Phone No. (509) 324-9256 ext. 231

25